

### **III. REMARKS**

#### **Status of the Claims**

Claims 1 and 14 are amended. Claims 1-26 are presented for further consideration.

#### **Summary of the Office Action**

Claims 1-5, 10, 11, 14-18, 23 and 24 stand rejected under 35USC102(e) on the basis of the cited reference Verdonk, U.S. Patent No. 6,330,454. Claims 6-9, and 19-22, stand rejected under 35USC103(a) based on the reference Verdonk in view of the cited reference Willars, et al, U.S. Patent No. 6,285,667. Claims 12, 13, 25, and 26 stand rejected under 35USC103(a) based on the reference Verdonk. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

Applicant has amended the claims to overcome the rejection based on 35USC112 and to correct a typographical error. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. The Examiner is requested to exercise his discretion and enter these amendments.

#### **Discussion of the Cited Reference**

The Examiner continues to rely primarily on the cited reference Verdonk to support the rejection based on anticipation and as the primary reference to support the rejection based on obviousness.

Although the cited reference Verdonk mentions packet-switching, no network elements of a packet switched network are actually shown or described. The disclosure of Verdonk is therefore unclear as to whether or not the radio interface between the base

station and the subscriber terminal is packet-switched. It is quite possible that the packet-switched information is actually transmitted in a circuit-switched radio connection.

A further significant distinguishing factor between the disclosure of Verdonk and the present independent claims involves the information content of the paging response message. In Verdonk, the paging response message is a normal prior art paging response message. At the most, it may include the identity of the serving cell, but even this is not clear as indicated in Applicant's previous response.

Applicant submits that, the Examiner is correct in the interpretation applied to the expression: "other information useful in location determination" as including "timing information of radio connection". However, the reference Verdonk does not disclose "timing information of radio connection", because, in Verdonk, only a time stamp indicating what time the location was last determined is disclosed. According to the present application, paragraph [0060], timing information includes a timing advance factor or the round trip time, as is well-known for the person skilled in the art. Timing information of radio connection has a well-established meaning in the art and it does not include time stamps.

The system of Verdonk is, therefore, missing several features of the subject application according to independent claim 1 and 14, as amended. Accordingly, the reference Verdonk does not support the rejection based on anticipation.

The Examiner is reminded that the anticipation analysis requires a positive answer to the question of whether the system of Verdonk would infringe the claims of this application if it were

later.

Claim 1 of this application includes the following feature:

**"locating the subscriber terminal on the basis of the information included in the paging response message, wherein said information comprises identity of a serving cell and other information useful in location determination."**

Since this feature is not present in the system of the reference Verdonk, there can be no infringement of the subject claims. Equivalent language appears in independent claim 14. Therefore the teaching of Verdonk does not support the rejection based on anticipation with respect to any of the claims.

#### **The Issue of Obviousness**

As previously submitted, the disclosure of cited reference Verdonk is deficient beyond what the Examiner has indicated and these deficiencies are not remedied by the proposed combination with the teaching of the reference Willars. The system of Willars is described in column 2, lines 11-15 as follows:

**"In the preferred embodiment of the present invention, the simultaneous call connection is accomplished using a unique page procedure between the core networks, generic radio access network, and mobile station to which the simultaneous calls are destined."**

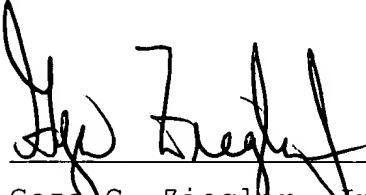
This unique page procedure allows a mobile station to receive simultaneous messages from two different core networks, while employing only a single channel between the generic radio access network and the mobile station. There is no mention of a locating service that is initiated by a page from a mobile unit. The Examiner indicates that this reference in combination with the reference Verdonk teaches the initiation of a location request by a mobile terminal. This is speculation by the Examiner, as there is nothing in these references to support the

Examiner's position. Applicant submits that the modification of the teachings of Verdonk and Willars, in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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4 OCTOBER 2005

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